

APPN: 09/134,831 (Reissue)

Patent 5,602,905

Filed: August 17, 1998

Appeal number: 2008-0610, September 30, 2008

Appellant: Richard P. Mettke

Title: On-line Communications Terminal/Apparatus

Group Art Unit: 2743

NOTICE

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**NOTICE OF APPEAL TO THE U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT**

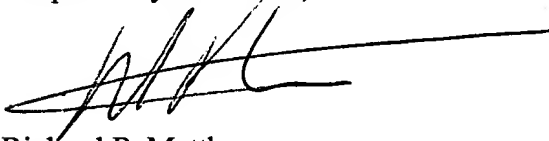
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Sir:

Applicant Richard Mettke hereby provides notice that he is appealing to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. §§ 141 and 142 from the decision of the Board of Patent Appeals and Interferences dated, September 30, 2008.

Simultaneously herewith, three copies of this notice and the fee prescribed by Federal Circuit Rule 52 Federal Circuit Rules of Practice, 2008 edition are being transmitted to the clerk of the Federal Circuit in accordance with 37 C.F.R. § 1.301 and Federal Circuit Rule 15(a)(1).

Respectfully submitted,



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**I HEREBY CERTIFY THAT THE FOREGOING NOTICE OF
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FORM 5. Petition for Review or Notice of Appeal of an Order or Decision of an AGENCY, BOARD, OR COMMISSION.

15 NOV 08

United States Court of Appeals for the Federal Circuit

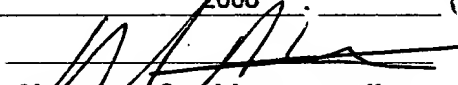
Richard P. Mettke, Pro Se Petitioner or Appellant.

v.

PETITION FOR REVIEW

Board of Patent Appeals and Interferences Respondent or Appellee.

Richard P. Mettke, Pro Se (name all parties* bringing the petition or appeal) hereby petition/appeal the court for review of the Denial of Appeal/2008-0610 (describe the order or decision and include decision number) of the Board of Patent Appeals and Interferences (name the agency, board, or officer) entered on September 30 2008 (date). The order or decision was received on October 7 2008 (date).


(Signature of petitioner, appellant or attorney)

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*See Fed. R. App. P. 15 for permissible ways of identifying petitioners.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD P. METTKE

Appeal 2008-0610
Reissue Application 09/134,831
Patent 5,602,905
Technology Center 2600

Decided: September 30, 2008

Before LEE E. BARRETT, JAMESON LEE, and SALLY C. MEDLEY,
Administrative Patent Judges.

BARRETT, *Administrative Patent Judge.*

*
DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the final rejection of claim 6. We have jurisdiction pursuant to 35 U.S.C. § 6(b).

We affirm.

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REISSUE and PROTESTS

This application was originally filed on August 17, 1998, for reissue of U.S. Patent No. 5,602,905 (the '905 patent), entitled "On Line Communication Terminal/Apparatus," by inventor Richard P. Mettke, issued February 11, 1997, based on Application 08/376,247 ('247 application), filed January 23, 1995. The reissue declaration by Mr. Mettke states that he believes the patent to be wholly or partly inoperative or invalid by reason of claiming less than he had a right to claim, in particular, because he removed the word "Internet" from the specification and the claims without submitting additional claims directed to an online communications terminal for accessing the Internet.

Protests to the reissue were filed under 37 CFR § 1.291(a) by:
(1) TouchNet Information Systems, Inc. on November 4, 1998; (2) North Communications, Inc. on March 31, 1999; and (3) Griffes Consulting, SA, on behalf of Landis & Gyr Communications on August 11, 1999.

RELATED LITIGATION

Mettke v. Hewlett Packard, Co. and North Communications, Inc., No. CV 97 TMP 3160 E (N.D. Ala. filed December 8, 1997), was dismissed with prejudice by Order entered December 8, 1999.

Mettke v. TouchNet Information Systems, Inc., No. CV 98 PT 0596 E (N.D. Ala. filed March 16, 1998), was dismissed with prejudice by Order entered September 21, 1998.

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PRIOR APPEAL and RCE AMENDMENTS

A prior appeal in this reissue application, Appeal 2006-0625, was decided August 31, 2006, in which the Board affirmed the rejection of claims 6-9 over 35 U.S.C. § 103(a), affirmed the rejection of claim 7 under § 112, first paragraph, for lack of written description, and entered a new ground of rejection of claims 6-9 under § 103(a). Appellant was informed that the new ground of rejection was not considered final for purposes of judicial review and that Appellant had the choice to reopen prosecution or to request rehearing (Appeal 2006-0625, p. 59). Appellant elected to file a request for continued examination (RCE) under 37 C.F.R. § 1.114 on October 25, 2006, and prosecution on the merits was reopened.

In the RCE, Appellant canceled dependent claims 7-9 and amended the sole independent claim 6 to delete several limitations. The Examiner maintains the rejections in Appeal 2006-0625.

BACKGROUND

The original '905 patent application, the '247 application, as filed, disclosed a public pay-for-use terminal for creating, sending, and receiving facsimiles; word processing operations; e-mail operations; and accessing online service providers (such as Prodigy and CompuServe) and Internet providers. All but three mentions of the Internet were canceled. The '905 patent no longer describes facsimiles, e-mail, word processing, or the growth of the Internet and use of the Internet for personal and leisure activities. The

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claimed invention and the applied prior art will be better understood in the context of the original disclosure of a general purpose public terminal.

The background of the invention the '247 Application, as originally filed, describes (p. 2):

In the past few years there has been a remarkable growth in the use of commercial on-line service providers (I.E. PRODIGY, COMPUSERVE, AMERICAN ON-LINE, and DELPHI), Internet providers and use of FAX machines. The use of the above listed services are normally conducted in the home or office.

Many businesses use E-mail (through an on line service or the Internet) to conduct day to day operations In addition, businesses constantly draw from the wealth of data bases of information available from the on-line services and the Internet.

Commercial and Internet on-line members also access the services for personal and leisure activities These services are generally accessed from fixed site locations at home or in the office. Although, portable terminals (lap top computers) with modems are available; they are often cumbersome and are not user friendly for a travelling business people or other users of on-line services or the Internet on the road.

The current pay as you use FAX machine requires users to have a hard copy document to send; and virtually none are able to receive in a user friendly configuration. In many situations, it is impractical for a user to have a hard copy document in hand to send. This invention will allow a user to create a document on screen and FAX it out, as well as provide for a header and print out a copy of the message sent. A telephone will also be located in the terminal cubicle to instruct the sender to transmit a FAX to the terminal location.

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An added feature of the terminal would allow for minor word processing at its terminal. This would be a highly desirable service for business people/individuals on the go that would require its service. . . .

The '247 application, as originally filed, described that "(b) Users can create, send and receive FAX's from the terminal" (p. 4) and "(c) Users can conduct word processing operations and send the file via e-mail to another fixed terminal" (p. 4), but these applications were deleted (note the omission of (b) and (c) in the '905 patent at col. 2, l. 13).

The apparatus is a "[t]erminal device which is comprised of the monitor, keyboard w/mouse, central processing unit w/internal modem (14,4-28 BPS), integrating software, laser printer, credit card swiping device, telephone and telephone lines" ('905 patent, col. 2, ll. 42-46). "Users will pay for the use of the terminal using a credit card swipe apparatus. The user will be charged for use of the terminal, telephone line use charges and additional charges by the commercial on-line service or internet provider." (*Id.* at col. 2, ll. 16-20.)

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THE CLAIM

Claim 6, the sole claim, is reproduced below.

6. A public on line Internet terminal comprising:
- a central processing unit (CPU);
 - a video display monitor coupled to the CPU;
 - a keyboard for providing user interface coupled to the CPU;
 - a credit card reader swipe device coupled to the CPU for accepting payment by a user;
 - means for accessing the Internet and allow for user interaction;
 - software installed into the CPU to allow interface with the Internet and credit card service centers; and
 - a printer coupled to the CPU.

THE REFERENCES

Rawn Shah, *Suggestions for Information Kiosk Systems using the World Wide Web*, <http://www.rtd.com/people/rawn/kiosk-paper.html> (April 30, 1994), download date 2/3/99, pp. 1-5 (Exhibit I to Protest by North Communications, Inc.) (hereinafter "Shah").

TOUCHFAX AMERICA, video tape recorded May 14, 1993, and distributed by TouchFax Information Services as advertising at the May 1993 Comdex in Atlanta, Georgia, 1993, TouchFax Information Services, Inc., (Exhibit C to TouchNet Protest) (Artifact No.

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09134831VA), including six printouts of frames from the video tape (Exhibit C, 1 to Exhibit C, 6) (Artifact No. 09134831CA) (hereinafter "Exhibit C").

TouchFax Network Topography Diagram, 1991 TouchFax Information Systems, Inc. (Exhibit D to TouchNet Protest) (hereinafter "Exhibit D").

Allen Weiner, *TouchFax Provides the Ultimate In Place-Based Interactivity*, Interactive World (October 1992), pp. 48-49 (Exhibit E to TouchNet Protest) (hereinafter "Exhibit E").

VISION . . . POWER . . . VERSATILITY, F700 Public Communications Terminal brochure, TouchFax Information Systems, Inc. (1991) (Exhibit F to TouchNet Protest) (hereinafter "Exhibit F").

Landis & Gyr, *ISDN console, Public telephone and telematic console*, available in 1988 (Exhibit C to Protest of Griffes Consulting SA) (hereinafter "*L&G ISDN console*").

Paul Gilster, *The Internet Navigator* (2d ed. John Wiley & Sons, Inc. 1994), pp. 15 18, 24, 25, 56, 57, 195, 221-225 (hereinafter "*Internet Navigator*").

Andrew Cantor, *Aliens Among Us*, Internet World, Nov/Dec 1994, pp. cover, index (2 pages), 82-84 (hereinafter "*Aliens*").

On Haiti, Shooting From the Lip, Washington Post, October 6, 1994, from Lexis/Nexis (hereinafter "*On Haiti*").

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THE REJECTIONS

The Examiner maintains the rejections in Appeal 2006-0625.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Exhibit E, Exhibit F, and Shah. This corresponds to the Examiner's ground of rejection affirmed in Appeal 2006-0625.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Exhibit C, Exhibit D, Exhibit E, Exhibit F, *L&G ISDN console*, *Internet Navigator*, *Aliens*, and *On Haiti*. This corresponds to the new ground of rejection entered by the Board in Appeal 2006-0625.

THE ISSUES

The general issue is whether Appellant has shown reversible error in the rejections of claim 6. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

Specifically, the argued issues are:

- (1) Are Exhibits C, D, E, F, and the *L&G ISDN console* references nonanalogous art? *See Scope of the art* under Findings of Fact.
- (2) Does e-mail access to the Internet "allow for user interaction"? *See discussion of Aliens* under *Content of the references* in Findings of Fact.

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(3) Is a reference invalid because it has only 26 words? *See* discussion of *On Haiti* under *Content of the references* in Findings of Fact.

(4) Does Shah teach a kiosk connected to the Internet? *See* discussion of Shah under *Content of the references* under Findings of Fact.

(5) Is Appellant's "evidence" of nonobviousness entitled to any weight? *See Objective evidence of nonobviousness* under Findings of Fact.

(6) Is the fact that Exhibits C-F are all from the same company and describe variations of the same pay-for-use terminal insufficient motivation to combine their teachings? *See Motivation* under Findings of Fact.

(7) Does the fact that Exhibits C-F describes a terminal that was never actually built require that the references be disregarded? *See Exhibits C-F are good for all they describe* under Discussion.

(8) Did the Board have authority to enter a new ground of rejection in Appeal 2006-0625? *See The Board has authority to enter new grounds of rejection* under Discussion.

(9) Does the statement that "'The TouchFax is designed to emulate exactly what a person will be able to use in their homes,' says Massey" (Exhibit E) provide a suggestion to add Internet access to a pay-for-use terminal when Internet access is common in homes? *See Rejection over Exhibit E, Exhibit F, and Shah* under Discussion.

PRINCIPLES OF LAW

"[T]he test [for obviousness] is what the combined teachings of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). A rejection under 35 U.S.C. § 103(a) is based on the following factual determinations: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) any objective indicia of non-obviousness. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966)). Whether there is motivation to combine or modify the references is a question of fact drawing on the factors of *Graham*. See *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52 (Fed. Cir. 2001).

"To facilitate review [of an obviousness determination], this analysis should be made explicit. See *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) ('[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness'). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR Int'l Co.*

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v. Teleflex Inc., 127 S. Ct. 1727, 1741 (2007). "A person of ordinary skill is also a person of ordinary creativity, not an automaton." *Id.* at 1742.

FINDINGS OF FACT

Scope of the art

References must be within the scope of the prior art, i.e., they must be from analogous art. *See In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986) (the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1535, 218 USPQ 871, 876 (Fed. Cir. 1983) ("The scope of the prior art has been defined as that 'reasonably pertinent to the particular problem with which the inventor was involved'").

Appellant's disclosed field of endeavor appears to be best defined as pay-for-use public communication terminals because the '905 patent discloses a pay-for-use public access terminal for communicating with commercial online service providers and Internet providers and because the '905 patent application as originally filed also disclosed that the terminal would send and receive facsimiles and e-mails. The particular problem with which Appellant was concerned in claim 6 was a pay-per-use public communication terminal for providing access to the Internet.

Exhibits C, D, E, F, *L&G ISDN console*, and *On Haiti* relate to pay-for-use public communication terminals and are at least within the

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inventor's field of endeavor. Shah relates to providing Internet access in a public access kiosk and is in the field of public access communications terminals and is at least pertinent to the problem of providing Internet access in a public access terminal. The *Internet Navigator* and *Aliens* relate to online service providers and access to the Internet and are reasonably pertinent to the problem of providing Internet access. Thus, we find the references to be within the scope of the prior art.

Appellant argues that Exhibits C, D, E, F, and the *L&G ISDN console* are not within the field of endeavor and are not pertinent to the rejection (Br. 13). It is argued that the definition of the field of endeavor as "pay-per-use public communication terminals" is too broad because "[c]ommunications relates to many sub areas, facsimile machines, telephones, televisions, cellular phone and global positioning systems just to mention some of the areas. A more narrowed (and correct) field of endeavor would have been 'Internet.'" (Br. 13.)

These arguments define the field of the inventor's endeavor much too narrowly. A public pay-for-use terminal having Internet access is within the broad field of endeavor of pay-for-use public communications terminals. Moreover, the '905 patent, as originally filed, described a general purpose pay-for-use public terminal having many of the same functions described in Exhibits C, D, E, F, and *L&G ISDN console*, and the similarity in structures indicates that they are all within the scope of the relevant prior art.

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Content of the references

Exhibit C

Exhibit C is a video tape recorded May 14, 1993, and distributed by TouchFax Information Services as advertising at the May 1993 Comdex trade show in Atlanta, Georgia, and Exhibits C, 1 to C, 6 are printouts of selected video frames. Exhibit C is a prior art "printed publication" under 35 U.S.C. § 102(b), *see In re Wyer*, 655 F.2d 221, 226 (CCPA 1981) (the key to a "printed publication" is the "probability of dissemination" rather than the form), or at least is prior art "known by others in this country" under § 102(a). The video tape advertises TouchFax kiosks for a variety of purposes including pay-per-use access to the Prodigy online computer service provider and for connection to the Internet. No kiosks had been built to actually perform these functions.¹ Exhibit C, 1 shows the opening title

¹ See Deposition of Daniel Toughey, President of TouchFax, in Civil Action No. 98-PT-596-E, pp. 44-45, indicating that video was a marketing tool, intended to show possible uses:

Q: (By Mr. Polasek [Attorney for Appellant]) Now that we have been able to stop the tape, it shows a rectangular gold block labeled [sic] internet. I think it is right at -- I thought it was the 36 second mark. It may be 34.

MR. STITT [Attorney for Defendant]: It appears to be 34.

Q: (By Mr. Polasek) Did that provide for access to the internet? If the user was to touch that icon, I guess is what you would call it, that

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and production date of May 14, 1993. Exhibit C, 2 shows a customer inserting a credit card into the TouchFax unit to activate the unit. Exhibit C, 3 advertises connection to the Prodigy Information Service, a well-known commercial online service provider in 1993. Exhibit C, 4 advertises connection to the Internet. Exhibit C, 5 shows a user at a TouchFax unit using the keyboard and showing the credit card reader device. Exhibit C, 6 shows a second display of the Prodigy Information Service being offered as an online connection option.

Exhibit D

Exhibit D is a diagram teaching use of a TF750 Public Terminal as a data and communications system. Exhibit D teaches a system which includes a "TouchFax Electronic Library" which serves as a "Gateway to Fax & Computer Services." The computer services include an "on-line interactive data base" including "CompuServe, Prodigy" online providers.

portion of the TouchNet screen, does that enable a user to gain internet access or do you know?

A: Not at that time, no. That was like MCI mail above it. Those are possible uses for the system. And so the reason we built this video was to sell our systems. And so, again, the vision of TouchFax, TouchNet was its multipurpose information communication terminal that, depending on what our customers, whoever owned these things wanted to provide, they could provide that type of information.

Exhibit E

Exhibit E discloses a free-standing pay-for-use TouchFax TF750 public communications terminal (kiosk) for locations such as airports, hotels, truck stops, and supermarkets (p. 48). Services include phone, fax, computer, word processing, copying, and information services (p. 48). The TouchFax terminal has a microprocessor, a touch-screen monitor, a data port for modem and laptop connections, a full-size keyboard, and a laser printer (p. 49, left col.). "Payment for services is made by using credit card or other magnetic card such as a telephone calling card." (P. 49, left col.) The user can connect via a modem to the Official Airline Guide (OAG) database and receive a facsimile report (p. 49, right col.). Exhibit E states that "The TouchFax is designed to emulate exactly what a person will be able to use in their homes," says Massey" (p. 49).

Exhibit F

Exhibit F discloses a "TF700 Public Communications Terminal from TouchFax," in a stand-alone housing including a telephone, speaker, touch-screen monitor, a credit card reader for payment of services, a full-sized keyboard for "computer database access or word processing," an option panel, a flatbed scanner, a 386 CPU, and a laser printer. Services include "telephone, send or receive a fax, photocopying, word processing and laser printing, and access to a growing number of information databases from Wall Street news to international sports scores." Exhibits E and F

essentially describe the same terminal, the differences being that the TF750 had a sloped countertop instead of the flat countertop in the TF700, and the TF750 had the keyboard in the countertop instead of a motorized retractable keyboard in the TF700. *See* Toughey deposition, pp. 55-59 (Exhibits 12 and 7 in Toughey deposition correspond to Exhibits E and F, respectively, in the TouchFax protest and this appeal).

Internet Navigator

The *Internet Navigator* describes that the Internet is a network of networks, which is made from computers and cables (p. 15). The Internet provides many different applications or services, such as e-mail, file transfer, and remote login (pp. 24-25). Commercial online services,² such as

² "Online service provider" is defined in "http://en.wikipedia.org/wiki/Online_service," where the original meaning is what applied in 1994:

An online service provider, in modern usage refers to an entity which provides a service online. It can include internet service providers and web sites, such as Wikipedia's or Usenet (commonly accessed through Google Groups). In its original more limited definition it referred only to a commercial computer communication service in which paid members could dial via a computer modem the service's private computer network and access various services and information resources such a bulletin boards, downloadable files and programs, news articles, chat rooms, and electronic mail services. The term "online service" was also used in references to these dial-up services. The traditional dial-up online service differed from the modern Internet service provider in that they provided a large degree of

CompuServe, were centralized private networks as opposed to distributed public networks like the Internet (pp. 17-18). "[C]ommercial providers such as CompuServe, GENie, and Prodigy have all made Internet mail access available" (p. 16; *see also*, pp. 57, 195; e-mail at pp. 221-225). Thus, many online service providers, such as Prodigy, provided access to the Internet via e-mail. The World Wide Web (Web) is a collection of documents linked by hyperlinks and Uniform Resource Locators (URLs) and is a service that runs on the Internet.³ Claim 6 recites access to the Internet, not to the Web.

Aliens

Aliens describes that online service providers such as America Online (AOL), CompuServe, GENie, and Prodigy were providing access to more features of the Internet in 1994. It is also stated that many of the services have offered e-mail gateways to the Internet for some time; e.g., "Like the other on-line services, CompuServe has offered an e-mail gateway to the

content that was only accessible by those who subscribed to the online service, while ISP mostly serves to provide access to the internet and generally provides little if any exclusive content of its own.

³ "[T]he Internet and the World Wide Web are not synonymous: the Internet is a collection of interconnected computer networks, linked by copper wires, fiber-optic cables, wireless connections etc.; the Web is a collection of interconnected documents, linked by hyperlinks and URLs, and is accessible using the Internet. The Internet also provides many other services including e-mail, file sharing and others"
"http://en.wikipedia.org/wiki/Internet."

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Internet for some time . . ." (p. 83); "GEIE has been offering an e-mail gateway to and from the Internet for several years, but nothing more" (p. 84); "Prodigy already has an e-mail gateway to the Internet . . ." (p. 84). "E-mail" service over the Internet is "access to the Internet," as recited in claim 6. *Aliens* describes that some online services charged hourly fees for Internet services (p. 84).

Appellant argues that "access to the Internet" using e-mail is not enough, and asks "What about interface?" (Br. 11). It is argued that "Claim 6 states 'accessing the Internet', as well as interfacing with the Internet" (Br. 11). "Clearly the claims in 6 say access and interface with the Internet. You either have access and interface or not." (Br. 11.)

Appellant ignores that *Aliens* describes that online service providers were providing more features of the Internet in 1994 than just e-mail and that there inherently had to be some program to "allow for user interaction." For example, *Aliens* describes that "AOL now offers a Gopher client and limited access to some WAIS databases" (p. 82), which are both Internet services, and "[t]he two applications have been combined under a single interface: a Gopher-like series of menus that present either text files or other menus" (p. 82). Thus, *Aliens* expressly describes the claim limitation of "means for accessing the Internet and allow for user interaction" from a commercial online service provider in 1994.

In addition, Appellant has not shown why e-mail service on the Internet does not meet the limitation of "means for accessing the Internet and

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allow for user interaction" in claim 6. The phrase "allow for user interaction" refers to a function, not an "interface," as argued, and Appellant does not point out where this limitation is defined in the '905 patent. Appellant does not dispute that the hardware, program, and service provider for e-mail service over the Internet were "means for accessing the Internet." The limitation "means for . . . allow for user interaction" requires no more than structure for user interaction, for example, a monitor and program to allow viewing a e-mail on the monitor and a keyboard for sending a response. Claim 6 recites "accessing the Internet" and the Internet is a network of networks—claim 6 does not recite accessing any particular application on the Internet. In any case, *Aliens* is only one of several references in the obviousness combination that indicates it was known to provide access to the Internet.

L&G ISDN console

L&G ISDN console describes a free-standing ISDN (Integrated Services Digital Network, an international standard for switched, digital dial-up telephone service for voice and data) payphone capable of accessing Videotex services available to the general public. Videotex was the first attempt at interactive information delivery for shopping, banking, news, etc. Videotex uses a box and keyboard associated with a video display. Data are delivered by phone line and stored in the box as predefined frames with

limited graphics that are retrieved by menu.⁴ The payphone has a telephone access node (required in a payphone); a credit card reader; a video display monitor; a keyboard; a modem (inherently required to connect to the Videotex service); means (software and hardware) to access commercial online Videotex services; and must contain a microprocessor. "The Landis & Gyr ISDN console enables the public to obtain access to the usual services and sources of information and to new services, all via the same terminal." "For administration of calls made on credit, the Landis & Gyr console connects itself to a specific centralized system, in particular for the phases of authorization and, at the end of the session, for the collection of the relevant data." "[Videotex] services are selected by means of instructions entered via the keyboard using a syntax determined by well defined rules and the requested data are presented in the form of full pages in colour." No printer is disclosed.

Landis & Gyr is an exclusive European distributor of the TouchFax terminals (Exhibit F). Thus, we find that the teachings of Exhibits C-F are related to the teachings of the *L&G ISDN console*.

Appellant agrees (Br. 12) with a statement by the Examiner that the *L&G ISDN console* "lack certain elements in the claims, such as a printer, touch screen interface and Internet access" (Office Action August 24, 1999).

⁴ See "<http://en.wikipedia.org/wiki/Videotex>."

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To the extent this statement can be construed as an argument that *L&G ISDN console* is not relevant, it does not address the rejection as a whole and does not address the fact that *L&G ISDN console* teaches, *inter alia*, connection to a centralized credit card center.

On Haiti

On Haiti describes that "'Cyberia' -- a 'cyberspace cafe' -- has opened recently in central London offering coffee, cakes and connection to the Internet. Connect charge: 1.95 British pounds per half-hour." The computers for this cafe inherently must have a CPU, monitor, keyboard, modem, means for accessing the Internet and allowing user interaction, and software installed into the CPU to allow interface with the Internet. Thus, *On Haiti* discloses payment for use of a terminal to access the Internet, but does not describe payment using a credit card reader swipe device connected to a credit card service center, and does not describe a printer.

Appellant argues that *On Haiti* has only 26 words which is not enough information to assess this prior art (Br. 12).

Appellant cites no authority for the proposition that prior art has to have a certain minimum length. *On Haiti* expressly discloses charging for access to the Internet from a public computer and Appellant has not shown how these words are meaningless to one of ordinary skill in the art.

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Shah

Shah discloses a kiosk based information system using the World Wide Web on the Internet as an interface (abstract). Shah discloses that the advantages of using the Web are: its popularity, it is already a multimedia tool, the user will have access to the many services on the Internet, and it is an accepted standard as opposed to a proprietary system (pp. 1-2). The kiosk includes input, output, processing, and network connection hardware, and Web browser software. (p. 2 under "The Access Interface"). Shah states (p. 5): "Commercial organizations may also wish to charge customers for access to specific documents or services. The concept of registered users and billing may be built into the server."

We stated in Appeal 2006-0625 that "Shah discloses a kiosk-based information system using the World Wide Web on the Internet as an interface (abstract)" (op. 27). Appellant argues that "Shah teaches away from accessing the Internet" (Br. 17) because Shah only wants to use a World Wide Web (Web) "interface" or browser and that when Shah refers to a "kiosk-based" system, he means a system which is not connected to the Internet (Br. 17-24).

Appellant misapprehends "Web" in Shah to mean "Web browser." The title of Shah, "Suggestions for Information Kiosk Systems using the World Wide Web," describes an information kiosk for providing information using the Web, not just a Web user interface as argued by Appellant.

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Shah specifically describes the advantages of using the Web for an information kiosk system. Shah states:

The first question that should be asked is why one would use the World Wide Web as a design for a kiosk-based information system. We have identified the reasons why the Web is ideally suited for this application:

- the Web has proven itself as a successful networked information system through its popularity on the Internet.
- a multimedia tool is the primary type of program used by information systems because of the combination of text, graphics and sound are more appealing. The many different Web browsers have these capabilities already.
- the Web is part of the Internet. This allows users access to the many services on the Internet.
- the ability of the Web to access other programs and services allows programmers to extend the capabilities of the server.
- the Web is a widely accepted standard as opposed to proprietary commercial multimedia systems which holds promise for its growth and development.

(Shah, "The Effectiveness of the World Wide Web as Kiosk-based Information System," pp. 1-2) When Shah asks "why would one use the Web as a design for a kiosk-based information system," he refers to the "Web," not a "Web browser." Shah states that one of "the reasons why the Web is ideally suited for this application [of a kiosk-based information system]" (p. 1.) is because "the Web is part of the Internet. This allows users access to the many services on the Internet" (p. 2). Appellant does not explain how this can be construed to mean anything other than the kiosk

users having access to the Web and Internet. Shah summarizes that "[t]he Web naturally lends itself to a distributed kiosk-based information system . . ." (Shah, "Abstract," p. 1), which indicates that the Web is being used for a "distributed" information system, not just a Web browser as argued.

Shah discloses that a "Kiosk-based Information system has many requirements to create the most user-friendly interface while maintaining security and functionality" (Shah, "Introduction," p. 1), and describes requirements for a user-friendly interface (Shah, "The Access Interface," p. 2-3, including "Physical Requirements" and "User Interface Program") and other requirements (Shah, "The Server," "Functionality," "Storage and Transfer," "Security," and "Control," pp. 3-5). Shah describes a Web browser as part of the overall kiosk design. However, Shah never indicates that the Web browser is not connected to the Web or Internet.

Shah indicates that kiosks may store information special to that information kiosk (Shah, "Who will use these systems?," p. 2), but this does not teach away from access to the Internet. Shah states that "[t]here has been varied interest by commercial and non-commercial organizations in the World Wide Web" (Shah, "Who will use these systems?"), further indicating that the kiosks will use the Web. Shah states that each kiosk is connected to a network (Shah, "The Server," p. 3), which indicates that the kiosk is not a self-contained information system. Shah states that "[t]he server should be able to access foreign databases which act as storehouses of raw data" (Shah, "Functionality," p. 4), which, taken in conjunction with the description of the

use of the Web, indicates that the data is accessed over the Internet. Shah also states that "data managers may wish to restrict certain areas of their Webspace dependent upon their own criteria" (Shah, "Security," p. 5) and Appellant has not said what "Webspace" can refer to other than a Web site on the Internet. Finally, Shah states: "Each installation should be able to decide which URI's are accessible through their server. Some installations may decide that they do not wish to provide their kiosks with access to the 'news' or 'mailto' services." (Shah, "Control," p. 5) The reference to URIs (Uniform Resource Identifiers) indicates access to the Web on the Internet.

Appellant apparently interprets "kiosk-based" to mean that there is no Internet access, i.e., that all the information is stored locally or on a network connected to the kiosk with no connection to the Internet. However, a "kiosk-based information system" just refers to an information system located in a kiosk (an interactive computer terminal available for public use usually contained in a housing) as opposed at home. Nothing in "kiosk-based information system" expressly or impliedly suggests that the information system excludes connection to the Web or Internet. Shah's discussion of "The Effectiveness of the World Wide Web as Kiosk-based Information System" indicates that there is access to the Web or Internet.

Appellant interprets "interface" in the statement "[t]he World Wide Web has provided the Internet with an easy interface" (Shah, second para. of abstract), to refer to a "user interface" or "Web browser." However, the sentence actually says that the Web, not a Web browser, is an interface to

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the Internet. Although Shah's kiosk design includes a Web browser, the browser is not limited to information stored on a private network.

Appellant argues that when Shah describes "The Effectiveness of the World Wide Web as Kiosk-based Information System," "he clearly is talking about the Web and it's user interface" (emphasis omitted) (Br. 19) and "it is only in the context of the Web (Browser) and its success on the Internet, not accessing the Internet" (Br. 19). We disagree. Shaw discusses "the reasons why the Web is ideally suited for this application [of a kiosk-based information system]" (Shah, "The Effectiveness of the World Wide Web as Kiosk-based Information System"), which clearly indicates that the Web (Internet) is being used, not just a system that is accessed by a Web browser. As noted by the Examiner (Final Rejection 6), Shah states that one reason why the Web is ideally suited for a kiosk-based information system is because "the Web is part of the Internet. This allows users access to the many services on the Internet" (*id.*). Appellant fails to explain how this can be interpreted in any other way than using the kiosk to access the Internet.

Therefore, Shah teaches a public kiosk connected to the Web/Internet.

Differences

Rejection over Exhibit E, Exhibit F, and Shah

The Examiner found that the difference between the subject matter of claim 6 and Exhibit E is that Exhibit E does not expressly disclose connecting the credit card reader to a credit card center.

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The Examiner found that the difference between the subject matter of claim 6 and the combination of Exhibits E and F is that Exhibits E and F do not describe accessing and interfacing with the Internet.

Rejection over Exhibits C, D, E, F, L&G ISDN console, Internet Navigator, Aliens, and On Haiti

In the new ground of rejection in Appeal 2006-0625, we found the differences between the subject matter of claim 6 and the pay-for-use public TouchFax terminal of Exhibits E and F are that Exhibits E and F: (1) do not expressly disclose connecting the credit card reader to a credit card center; (2) do not disclose providing access to the Internet; and, so, (3) do not disclose charging for using the computer terminal to access to the Internet.

We also found in the new ground of rejection that the differences between the subject matter of claim 6 and *On Haiti* are that *On Haiti* does not describe: (1) payment using a credit card via a credit card reader swipe device connected to a credit card service center; and (2) a printer.

Level of ordinary skill in the art

The level of ordinary skill in the art is best evidenced by the references. See *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978) ("the PTO usually must evaluate both the scope and content of the prior art and the level of ordinary skill solely on the cold words of the literature"); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995) (the Board did not err

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in adopting the approach that the level of skill in the art was best determined by the references of record).

The references of record demonstrate that those of ordinary skill in the relevant arts at the time of the filing of the '905 patent knew: (1) pay-for-use public communications terminals providing for pay-for-use telephone, facsimile, computer, word processing, databases, and communication services were well known, as evidenced by Exhibits C-F and *L&G ISDN console*; (2) access to the Internet was common in 1994 as evidenced by *Internet Navigator*, *Aliens*, *On Haiti*, and the background of the '905 patent; (3) commercial online service providers, such as CompuServe, AOL, and Prodigy, provided access to e-mail and other Internet services prior to Appellant's filing date, as evidenced by *Internet Navigator* and *Aliens*; and (4) charging for use of a public computer terminal to access the Internet was known as evidenced by *On Haiti* and Shah.

In addition, the level of ordinary skill in the art is evidenced by a letter by Mr. Gregory W. Adank submitted and relied upon by Appellant in his previous appeal (Appendix E to Appeal Brief in Appeal 2006-0625).

Mr. Adank stated (p. 1):

Upon complete review of your original patent application (8/376247) and patent number 5,602,905, reissue amendment filed on DEC 11, 2001, and USPTO Office Action dated MAR 12, 2002 (Examiner Woo), I would submit to you the following observations as someone skilled in the art.

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General Observations: The patent application articulates well a multitude of automation capabilities that one should considered "commonplace" in 1994. Typical home and business computers (Intel based 286/386 and other compatible class processors) were capable of performing all tasks and features described in your background description of prior art. Specifically, those systems were capable of sending and receiving faxes via internal or external modem, generating electronic documents and printing or faxing them to a remote terminal; communicate with on-line service providers (Prodigy, CompuServe, AOL), as well as to be used to communicate on the Internet via Internet service provider (ISP). The ability to couple a credit card reading device to a computer terminal was also common place during this time as many point-of-sale devices (i.e. cash registers) were in fact systems built from the core components found inside a computer terminal.

Thus, Appellant's own expert has stated that operation of the individual claim elements were known to those of ordinary skill in the art.

Objective evidence of nonobviousness

Objective evidence of nonobviousness (also called "secondary considerations") must always be considered in making an obviousness decision, *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538-39 (Fed. Cir. 1983), although it need not be necessarily conclusive, *Ashland Oil, Inc. v. Delta Resins & Refrac., Inc.*, 776 F.2d 281, 306, 227 USPQ 657, 674 (Fed. Cir. 1985). A "nexus" is required between the merits of the claimed invention and the evidence of secondary considerations in order for the evidence to be given substantial weight in an obviousness decision.

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Stratoflex, 713 F.2d at 1539. A "nexus" is a legally and factually sufficient connection between the objective evidence and the claimed invention, such that the objective evidence should be considered in the determination of nonobviousness. *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988). The burden of proving a nexus is on the applicant. See *Ex parte Remark*, 15 USPQ2d 1498, 1503 (BPAI 1990) *In re Huang*, 100 F.3d 135, 139 (Fed. Cir. 1996) ("In the ex parte process of examining a patent application, however, the PTO lacks the means or resources to gather evidence which supports or refutes the applicant's assertion that the sales constitute commercial success.").

The scope of the "[o]bjective evidence of non-obviousness must be commensurate in scope with the claims which the evidence is offered to support." *In re Tiffin*, 448 F.2d 791, 792 (CCPA 1971). The objective evidence is not commensurate in scope (coextensive) with the claimed subject matter if the claims are broader in scope than the scope of the objective evidence, e.g., if the product included elements or features not recited in the claims which may be responsible for the commercial success or praise. See *Joy Technologies Inc. v. Manbeck*, 751 F. Supp. 225, 229-30 (D.D.C. 1990) (and cases cited therein), *aff'd*, 459 F.2d 226 (Fed. Cir. 1992).

Appellant's "evidence" of nonobviousness is not entitled to any weight

Appellant argues that the "the results achieved by this invention are new (at the time of the original disclosure), unexpected, superior,

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unsuggested by any of the relied on prior art. Specifically, a public access terminal allowing interface and access to the Internet and allowing for use a credit card for use of the terminal or other activity." (Br. 25.)

Mere allegations of "unexpected results" are not sufficient to show nonobviousness. An "unexpected result" exists where the claimed invention achieves a different or greater result than the combination of prior art references would have suggested to the artisan, and is seldom a factor in the predictable mechanical and electrical technologies. Here, accessing the Internet, paying for use of a public communications terminal, and even paying for access to the Internet were known. The addition of access to the Internet to a known pay-for-use public terminal produces a completely predictable result and is not evidence of nonobviousness.

Appellant argues that the invention solves a different problem than the references, citing *In re Wright*, 848 F.2d 1216, 6 USPQ2d 1959 (Fed. Cir. 1988). "Specifically, a public access terminal allowing interface and access to the Internet and allowing for use a credit card for use of the terminal or other activity. No prior art reference implicitly or explicitly had the capabilities described in the appellant's claims at the time of the appellant's disclosure in January 1995." (Br. 25-26.)

Appellant does not state what different problem was solved. Nevertheless, an invention may be obvious for reasons the inventor did not contemplate. See *In re Dillon*, 919 F.2d 688, 693 (Fed. Cir. 1990) (en banc) (overruling-in-part *In re Wright*). As stated in *KSR*, obviousness is not

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limited only to consideration of the problem the patentee was trying to solve, and "[u]nder the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed," *KSR*, 127 S. Ct. at 1742. Thus, the problem that was solved is not conclusive evidence of nonobviousness. Appellant's argument that no single prior art reference met the limitations of claim 6 is an anticipation argument and does not address the obviousness ground of rejection.

Appellant argues that "[t]he prior art references do not contain any suggestion (express or implied) that they be combined, or that they be combined as the examiner and the BPAI suggests" and "[i]t would be necessary to make modifications, not taught in the prior art, in order to combine the references in the manner suggested by the examiner" (Br. 26).

These arguments relate to the obviousness rejection and are not separate evidence of nonobviousness. The obviousness conclusion is fully supported by motivation in the prior art as will be discussed.

Appellant argues that "[t]he fact that ~ eight references must be combined in two different methods (eleven counting the examiner) to meet the claims invention is unequivocal evidence of nonobviousness" (Br. 26).

"The criterion, however, is not the number of references, but what they would have meant to a person of ordinary skill in the field of the invention." *In re Gorman*, 933 F.2d 982, 986 (Fed. Cir. 1991). As discussed in the analysis, more than the minimum number of references

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were cited to evidence the level of skill in the art and to provide cumulative evidence of what was known in the art.

Appellant argues:

The Patent (5,602,905) that the applicant is prosecuting for reissue is referenced as prior art in 81 issued patents. A typical patent is mentioned as prior art ~ 6-12 times in issued patents. A patent that is mentioned ~12-30 times as prior art in issued patents is usually considered a technology leading patent and has a high rating factor for commercial success. So, I guess a patent that is mentioned 81 times as prior art in issued patents is a home run technology wise and commercial wise. This definitely points to nonobviousness.

(Br. 26.)

Appellant cites to no case law or other authority for the proposition that the number of citations of a patent is evidence of nonobviousness.

Appellant argues failure of others because "[p]rior to the applicant's January 1995 disclosure, no entity had produced a terminal that contained all of the elements of the applicant's claims" (Br. 27).

Appellant provides no evidence that others had tried to solve the problem of a pay-as-you-use terminal for providing Internet access. The argument is only that no anticipatory reference has been cited, but this is not persuasive because the rejection is based on obviousness. Allegation of an unsolved problem is not evidence of unobviousness unless it is shown that the widespread efforts of skilled workers having knowledge of the prior art

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had failed to find a solution to the problem. *In re Allen*, 324 F.2d 993, 997 (CCPA 1963).

Appellant argues commercial success based on charts of worldwide kiosk growth from Summit Research Consulting web site in April 2005. "Summit Research are considered experts in the Kiosk field. At Appendix D is an overview of an Internet Kiosk report in 2002 by Summit Research. The majority of these kiosk employ elements of the appellant's claims." (Br. 27)

The bar charts reproduced in the Summit Research Web page in Appendix D do not correspond to the charts in the revised appeal brief. Appellant does not provide any evidence to backup his statement that "[t]he majority of these kiosk employ elements of the appellant's claims." In any case, however, even pay-per-use Internet kiosks were commercially successful. Appellant has not provided the necessary nexus between the commercial success and the merits of the claimed invention. The scope of the "[o]bjective evidence of non-obviousness must be commensurate in scope with the claims which the evidence is offered to support." *Tiffin*, 448 F.2d at 792. Claim 6 recites only a pay-as-you-use Internet terminal with a list of elements. Appellant fails to show that any commercial success was not due to unclaimed elements and features of commercial kiosks, such as the fact that the elements were in a kiosk housing, the physical construction of the kiosk and its elements, location of the unit, ease of operation and use, speed of the Internet connection, price of the kiosk to own.

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and operate, price to the customer of using the kiosk, and a multitude of other factors that go into a successful commercial product.

For the reasons stated above, Appellant's "evidence" of nonobviousness is not entitled to substantial weight in the obviousness determination.

Motivation

Rejection over Exhibit E, Exhibit F, and Shah

The Examiner found that the communication software in Exhibit F would have suggested the use of communication software to communicate between the credit card reader device in Exhibit E and a credit card center.

The Examiner found that Shah teaches the desirability of providing access to the Internet in a kiosk-based information system in order to provide users with the many services on the Internet.

Rejection over Exhibits C, D, E, F, L&G ISDN console, Internet Navigator, Aliens, and On Haiti

The motivation to combine any of the teachings of TouchFax Exhibits C, D, E, and F is that all exhibits are from the same corporation, TouchFax, and expressly teach modifications, variations, and improvements to a pay-for-use public communications terminal. Thus, the teaching of Internet access in Exhibit C suggests modifying Exhibits E and F to provide Internet access, and the teaching on providing access to online service

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providers in Exhibit D suggests modifying Exhibits E and F to provide access to online service providers.

Since Exhibit C to Exhibit F disclose pay-for-use public terminals, this suggests payment for use of any service provided by the terminal, including services that may be added later.

The previous two paragraphs are unchanged from the Board's opinion in Appeal 2006-0625 (pp. 50-51). Appellant argues in this appeal:

The applicant respectfully disagrees that there is motivation to combine Exhibits C, D, E, and F and that they expressly teach the modifications to add Internet access and interface on a point-of-sale basis. The BPAI does not "show" objectively how the references teach this modification other than seeing the applicant's disclosure in January 1995.

(Br. 10.)

Appellant provides no reasons for his disagreement. Exhibits C, D, E, and F are all from the same corporation and all relate to versions of the same pay-for-use terminal. One skilled in the art would have been motivated to combine the teachings in one reference with teaching in another reference because they are all related to the same terminal apparatus, i.e., there is not the usual obviousness problem of explaining why one skilled in the art would have sought to combine two references from unrelated sources. The rejection discusses the motivation. As note above, we stated that "the teaching of Internet access in Exhibit C suggests modifying Exhibits E and F to provide Internet access"; i.e., Exhibit C, 4 expressly teaches providing

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Internet access on a pay-for-use terminal. We also stated that "[s]ince Exhibit C to Exhibit F disclose pay for use public terminals, this suggests payment for use of any service provided by the terminal, including services that may be added later," such as the Internet taught by Exhibit C, 4. To the extent Appellant's real argument is that there can be no teaching in these exhibits because there was no working embodiment, this is irrelevant, as discussed in "*Exhibits C-F are good for all they describe*," *infra*. The issue is what the references would have taught to one skilled in the art.

L&G ISDN console teaches connection of a credit card reader to a credit card center for authorization and collection of credit card charges, which expressly provides motivation for connecting credit card readers to a credit card center, if proof of this common fact is needed. Landis & Gyr is an exclusive European distributor of the TouchFax terminals (Exhibit F), so one of ordinary skill in the art would have been aware of the relationship between the TouchFax terminal of Exhibits C-F and the *L&G ISDN console* and have been motivated to combine their respective teachings.

Exhibit E states that "'The TouchFax is designed to emulate exactly what a person will be able to use in their homes,' says Massey" (p. 49), which suggests modification of the terminal to provide services on a public terminal as those services become common at home and business.

On Haiti discloses payment for use of a public terminal to access the Internet, which expressly provides motivation for charging for Internet access in other public terminals.

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The *Internet Navigator* and *Aliens* teach that online service providers provided access to e-mail and other services on the Internet in 1994, which expressly suggests that any access to commercial online service providers in 1994 would have provided access to the Internet.

DISCUSSION

Exhibits C-F are good for all they describe

Appellant argues throughout the brief that the TouchFax terminal described in Exhibits C, D, E, and F did not actually access the Internet or commercial online service providers, such as CompuServe and Prodigy, as of the publication dates, so statements therein are speculative and do not render claim 6 obvious (Br. 8; Br. 9; Br. 9-10; Br. 10; Br. 13-14; Br. 14; Br. 15; Br. 16). Appellant notes that the TouchFax terminal was not capable of accessing the Internet or commercial online service providers as of the date of the deposition of Daniel J. Toughey, President of TouchNet, on June 16, 1998, three and one-half years after the '905 patent was filed and these exhibits merely represent "a concept, experimental, an idea and marketing tool" (Br. 8; Br. 9). It is apparently Appellant's position that Exhibits C-F should be disregarded because they do not describe an actual commercial terminal for accessing the Internet or online service providers.

These arguments are not persuasive of error. There is no requirement that prior art under 35 U.S.C. § 102 describes an actual working embodiment. *See In re Blake*, 352 F.2d 309, 312 (CCPA 1965) ("patents are

valid as references for whatever they disclose; the statute does not require commercial use of the invention disclosed therein to qualify the disclosure for use as a reference"). "Even if a reference discloses an inoperative device, it is prior art for all that it teaches." *Beckman Instruments, Inc. v. LKB Produkter AB*, 892 F.2d 1547, 1551 (Fed. Cir. 1989). Exhibits C-F are good for all they would have taught or suggested to a person of ordinary skill in the art at the time of the invention. For example, Exhibit C, 4 shows a printout of a video frame which advertises connection to the Internet, which would have taught one skilled in the art to provide access to the Internet from a pay-per-use terminal. Appellant's arguments regarding Exhibits C-F are not entitled to substantial weight.

In order to render a claimed apparatus or method obvious, the prior art must enable one skilled in the art to make and use the apparatus or method. *See In re Payne*, 606 F.2d 303, 314 (CCPA 1979). Appellant does not argue that the references were not enabling to one of ordinary skill in the art, i.e., that it was not within the level of ordinary skill in the art to add access to the Internet as taught by Exhibit C, 4 or access to online service providers as taught by Exhibit D. Indeed, if Appellant argued that the references were not enabling, his own disclosure would have to be rejected as nonenabling because it provides no more detail than the references. *See In re Epstein*, 32 F.3d 1559, 1568 (Fed. Cir. 1994) ("Rather, the Board's observation that appellant did not provide the type of detail in his specification that he now argues is necessary in prior art references supports the Board's finding that

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one skilled in the art would have known how to implement the features of the references and would have concluded that the reference disclosures would have been enabling."); *In re Fox*, 471 F.2d 1405, 1407 (CCPA 1973) (appellant's specification "assumes anyone desiring to carry out the process would know of the equipment and techniques to be used, none being specifically described"); *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1569 (Fed. Cir. 1988) ("The disclosure in Exhibit 5 is at least at the same level of technical detail as the disclosure in the '491 patent. If disclosure of a computer program is essential for an anticipating reference, then the disclosure in the '491 patent would fail to satisfy the enablement requirement of 35 U.S.C. § 112, First ¶.").

The Board has authority to enter new grounds of rejection

Appellant argues that the Board should have limited its review to the four corners of the record and not have entered a new ground of rejection based on new prior art and that the Board should remove any mention of the newly cited references and any decision should be based on the record created by the Examiner (Br. 7, 28).

It is long settled that the Board has the authority to enter a new ground of rejection. *See In re Loehr*, 500 F.2d 1390, 1391 (CCPA 1974) ("The main issue in this appeal is whether the Board of Appeals has statutory administrative jurisdiction to reject appealed claims on new grounds. We

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affirm on this issue."); 37 C.F.R. § 41.50(b) (previously § 1.196(b)). Thus, the new ground of rejection will not be removed.

Appellant argues that the previous appeal was improperly given more scrutiny than other cases because the patent had been involved in litigation and because protests had been filed (Br. 7).

There is no error in giving some cases more attention than others. Each case demands a level of attention based on its own set of facts, issues and circumstances.

Obviousness

Rejection over Exhibit E, Exhibit F, and Shah

Appellant does not re-argue the Examiner's rejection based on Exhibit E, Exhibit F, and Shah. For purposes of judicial review, we summarize the rejection and the response to the main arguments from Appeal 2006-0625.

The Examiner found that Exhibit E did not "explicitly" describe software to interact with credit card centers (Final Rejection, March 12, 2002, p. 6). The Examiner found that Exhibit F discloses that "TouchNet network management software collects usage and billing data" and discloses a credit card reader allowing payment by major credit cards, and concluded that "it would have been obvious to an artisan of ordinary skill to use such installed software, as described in Exhibit F within the TouchFax terminal of Exhibit E to carry out communications functions with

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the credit card centers in order to authorize payments made via the credit card reader" (*id.*). The Examiner also found that Exhibits E and F did not describe accessing and interfacing with the Internet, but did allow for accessing a remote service provider (*id.*). The Examiner found that Shah teaches the desirability of providing access and interaction with the Internet in a kiosk-based information system, and concluded that "it would have been obvious to an artisan of ordinary skill to incorporate such means for accessing and software for interfacing with the Internet in a kiosk information system, as taught by the Shah article, within the combination of Exhibits E and F in order to provide users with access to the many services available on the Internet" (*id.* at p. 7).

Appellant argued that Exhibits E and F fail to disclose or suggest "means for accessing the Internet." The Examiner responded that Shah is relied upon for its teaching of Internet access via a kiosk. Appellant argued that Shah does not teach the use of any software for interfacing with credit card service centers and there is no discussion regarding how a user would pay for the use of the kiosks. The Examiner responded that Exhibit E provides a credit card reader to allow payment for services on the terminal.

We noted in Appeal 2006-0625 that nonobviousness cannot be established by attacking the references individually where the rejection is based upon the teachings of a combination of references. *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). That is, it was not persuasive for Appellant to argue that Exhibits E and F do not teach Internet access when

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the rejection relied on Shah for this feature, or to argue that Shah does not teach charging for use of the terminal services when Exhibits E and F are relied upon for this feature. Shah teaches, in 1994, providing Internet access from a public kiosk in order to give users access to the many services on the Internet. One of ordinary skill in the art would have been motivated to provide Internet access as an additional pay-for-use service in the public kiosks of Exhibit E and F to achieve this advantage. Since Exhibits E and F have dates of 1992 and 1991, respectively, before the Internet became widely accessible, it is not surprising that they do not mention the Internet. However, technology is not static and it would be expected that the kiosks would be updated to incorporate improvements in technology, such as access to the Internet, that may not have been foreseen at the time. Exhibit E states that "'The TouchFax is designed to emulate exactly what a person will be able to use in their homes,' says Massey" (p. 49) and the background of the '905 patent, as originally filed, admits that it was known to provide access to the Internet from home. Thus, there is a suggestion to modify the TouchFax to provide public Internet access to emulate the Internet access at home.

Appellant argues in the present appeal that he does not see how Exhibit E's statement that "'The TouchFax is designed to emulate exactly what a person will be able to use in their homes,' says Massey" (p. 49) "is a 'suggestion to modify' a TouchFax terminal to include Internet access and interface" (Br. 9) and it would only be a suggestion if "they (TouchFax) saw the applicant's disclosure and added this capability to their terminal" (Br. 9).

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We note that the principal reason for the obviousness modification is based on Shah. In addition, however, Exhibit E's statement suggests designing the TouchFax terminal to emulate whatever communication services persons have in their homes. Since Internet access was common at home and business at the time of filing of the '905 patent, as evidenced by the background of the '905 patent, and by *Internet Navigator* and *Aliens*, it would have been obvious to add Internet access to the terminal of Exhibits E and F because this is a service that persons would expect.

Appellant argued that "Exhibit F fails to disclose, teach or suggest software installed into the CPU to allow interface with the internet and credit card service centers" (Br. 15 in Appeal 2006-0625). The Examiner states that Exhibit F discloses that "TouchNet network management software collects usage and billing data."

It was not clear if Appellant was seriously arguing that the credit card reader in Exhibit F was not in communication with a credit card service center since no specific arguments were presented, or if he was merely arguing again the lack of Internet access. Internet access is taught by Shah. Exhibit F states that "TouchNet™ network management software collects usage and billing data, monitors equipment status and uploads documents, software and video screens." We noted that collecting usage and billing data does not precisely describe communication with credit card centers, but found that one of ordinary skill in the art of credit-card-based point-of-sale terminals at the time of the invention would have understood that connection

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of the credit card reader to a credit card center for authorization and charging is implied in Exhibits E and F (Appeal 2006-0625, p. 33).

The rejection of claim 6 is affirmed.

Rejection over Exhibits C, D, E, F, L&G ISDN console, Internet Navigator, Aliens, and On Haiti

This rejection applies more than the minimum number of references needed to meet claim 6 in order to provide cumulative evidence of the level of ordinary skill in the art and motivation, and to provide different ways to approach the obviousness question.

We analyze the obviousness issue two ways. First, Exhibits E and F are used as the main references because they describe a general pay-for-use public terminal, and we then show why it would have been obvious to modify the terminal to provide for pay-for-use access to the Internet. Second, *On Haiti* is selected as the main reference because it describes payment for use of a computer terminal to access the Internet, but does not disclose payment using a credit card reader or a printer, and we then explain why it would have been obvious to add a credit card reader and printer.

(1)

Exhibits E and F describe essentially the same pay-for-use public communications terminal providing services of receiving and sending facsimiles, word processing, copying, and printing. Although Exhibits E and F do not expressly teach that the terminal connects the disclosed credit

card reader to a credit card service, one of ordinary skill in the art of credit-card-based point-of-sale terminals at the time of the invention would have understood that connection of the credit card reader to a credit card center for authorization and charging is implied. Nevertheless, in the interest of addressing every possible arguable difference, *L&G ISDN console* teaches a credit card reader in a public communications terminal, which communicates with a credit card service center ("For administration of calls made on credit, the Landis & Gyr console connects itself to a specific centralized system, in particular for the phases of authorization and, at the end of the session, for the collection of the relevant data."). One skilled in the art would have been motivated to add a connection to the credit card center in Exhibits E and F to provide authorization of cards and collect amounts charged for communication services in view of *L&G ISDN console*.

There are at least three reasons why it would have been obvious to add access to the Internet as a pay-for-use feature on Exhibits E and F.

(1)(a)

Exhibit C, 4 expressly shows that the TouchFax terminal can be built to provide access to the Internet. The fact that Exhibit C is a later version of the TouchFax terminal of Exhibits E and F, and is by the same corporation, provides the express suggestion to modify Exhibits E and F to provide access to the Internet because this feature later became desirable. The fact that the terminal described in Exhibit C was not a working model is

irrelevant—it is sufficient that it teaches one skilled in the art that the terminal can connect to the Internet. Because Exhibits C, E, and F are pay-for-use public terminals, one skilled in the art would have been motivated to charge for access to all telephone, facsimile, and computer services, including an added computer service of access to the Internet.

For this reason, we affirm the rejection over Exhibits C, D, E, F, *L&G ISDN console*, *Internet Navigator*, *Aliens*, and *On Haiti*.

(1)(b)

Exhibit D describes that the TouchFax pay-for-user terminal can be connected to commercial online service providers, such as CompuServe and Prodigy, in 1991. Because Exhibits D, E, and F all relate to a TouchFax terminal, one of ordinary skill in the art would have been motivated to combine their individual teachings and, in particular, to modify Exhibits E and F to provide access to commercial online service providers as taught by Exhibit D. The fact that Exhibit D is not based on a working terminal is irrelevant. Because Exhibits D, E, and F are pay-for-use public terminals, one skilled in the art would have been motivated to charge for access to all telephone, facsimile, and computer services, including an added computer service of access to an online service provider.

The *Internet Navigator* and *Aliens* describe that online service providers had been providing access to the Internet via e-mail services for several years before 1994, which suggests that providing access to online

service providers as taught by Exhibit D would inherently have provided access to the Internet. In addition, *Aliens* describes that the trend among online service providers in 1994 was to provide access to more Internet features than just e-mail, so one of ordinary skill in the art would have been motivated to provide access to the Internet from the online service providers in Exhibit D. Therefore, Exhibit D, *Internet Navigator*, and *Aliens* would have suggested adding access to e-mail and other Internet services to the terminals of Exhibits E and F.

In addition, Exhibit E states that "'The TouchFax is designed to emulate exactly what a person will be able to use in their homes,' says Massey" (p. 49). The background of the '905 patent admits that it was known to provide access to the Internet from home and both *Internet Navigator* and *Aliens* also discuss that home access to the Internet was common. A person of ordinary skill in the pay-for-use communications terminal art would have been motivated to modify the TouchFax terminal to provide public access to the Internet to emulate the Internet access at home and to provide the common communication services expected by users.

For these reasons, we affirm the rejection over Exhibits C, D, E, F, *L&G ISDN console*, *Internet Navigator*, *Aliens*, and *On Haiti*.

(1)(c)

On Haiti expressly discloses charging for use of a public computer terminal to access to the Internet. One of ordinary skill in the art would have

been motivated to add pay-for-use Internet access to the pay-for-use public terminals of Exhibits E and F because it merely adds an additional pay-for-use service.

For this reason, we affirm the rejection over Exhibits C, D, E, F, *L&G ISDN console*, *Internet Navigator*, *Aliens*, and *On Haiti*.

(2)

On Haiti discloses charging for use of a public computer terminal which provides access to the Internet, but does not describe payment using a credit card, or using a credit card reader swipe device connected to a credit card service center, and does not describe a printer. One skilled in the art of credit card transactions would have been motivated to provide a credit card reader to allow users to charge their credit cards for the convenience of the service provider as well as the user in view of Exhibits E and F and the *L&G ISDN console*. Connection to a credit card center was so well known that its use is considered to be implied in Exhibits E and F, but, nevertheless, the *L&G ISDN console* expressly discloses connection to a credit card center for authorization and charging. One of ordinary skill in the art would have been motivated to provide a printer to the computer terminal in *On Haiti* because printers were used with computers to provide hard copy records of what was viewed, such as e-mails, and the use of printers with public computer terminals was known as evidenced by Exhibits E and F.

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For this reason, we affirm the rejection over Exhibits C, D, E, F,
L&G ISDN console, Internet Navigator, Aliens, and On Haiti.

CONCLUSION

Appellant has shown no reversible error in the rejections of claim 6
and the rejections of claim 6 are affirmed.

No time period for taking any subsequent action in connection with
this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

rvb

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